

REMARKS

The Office Action mailed September 1, 2009 has been reviewed and carefully considered. No new matter has been added.

Claims 1, 5, 7, 9, and 13-20 have been amended. Claims 1-20 are pending.

Claims 14-18 stand objected to under 37 C.F.R. 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Thus, Claims 14-18 have been amended to now depend from independent Claim 13 in accordance with the Examiner's suggestion. Withdrawal of the objection is respectfully requested.

Claims 1-18 and 20 stand rejected under 35 U.S.C. 102(c) as being anticipated by U.S. Patent Publication No. 2004/0203873 to Gray (hereinafter "Gray"). Claim 19 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Gray in view of U.S. Patent Publication No. 2004/0156372 to Hussa (hereinafter "Hussa").

It is to be noted that the independent claims in the case are Claims 1, 7, and 13.

It is respectfully asserted that Gray does not teach or suggest "transmitting a user initiated request from a user of a mobile device to a wireless service provider of a wireless network for a location of a wireless local area network (WLAN)", as now recited in amended Claim 1.

Moreover, it is respectfully asserted that Gray does not teach or suggest "a controller for processing a user initiated request from a user of the apparatus over said wireless network for a location of a wireless local area network WLAN and processing receiving over said wireless network said location of said wireless local area network WLAN" as now recited in amended Claim 7.

Further, it is respectfully asserted that Gray does not teach or suggest "a mobile device for sending a user initiated request from said wireless service area across said wireless network for a location of a wireless local area network WLAN" as now recited in amended Claim 13.

Support for the amendments to Claims 1, 7, and 13 (as well as Claims 5, 9, and 19-20) may be found at least at page 4, lines 2-5 and 18-19, and page 6, lines 1-3 of the Applicants' specification.

With respect to the above reproduced limitations of Claims 1, 7, and 13 relating to a user initiated request for a location of a wireless local area network (WLAN), the Examiner has cited the following portions of Gray: figure 5, reference steps 1-3; page 4, paragraph

[0035], lines 2-4; and paragraph [0036], lines 2-4. The Applicants respectfully disagree with the Examiner's reading of Gray.

With respect to figure 5, steps 1-3 are described at paragraphs [0034], [0035], and [0036] of Gray. Hence, essentially paragraphs [0034], [0035], and [0036] have been cited against the above reproduced limitations of Claims 1, 7, and 13.

Steps 1 and 2 are explicitly disclosed at paragraph [0034] of Gray as follows:

In step 1, WAN user 52 receives a message from the WAN network provider or MSC 30 (FIG. 3) that there is an email with attachment. In step 2, the network provider offers WAN user 52 the option of purchasing sufficient WLAN bandwidth from nearby WLAN access point 24 to perform a task, such as downloading e-mail attachment, sending email with attachment, sending video email, browsing the Internet, downloading web page or file from a web site and the like, using high speed WLAN network 20, such as the Internet 20.

Steps 1 and 2 are further described alternatively in paragraph [0035], which is reproduced in its entirety as follows:

In accordance with an embodiment of the present invention, steps 1 and 2 can alternatively involve WAN user 52 requesting the WLAN bandwidth on demand service from its WAN network provider to send an e-mail with an attachment, send video email, browse the Internet, download web page or file from a website, etc.

As is evident, paragraph [0035] of Gray does NOT disclose the following, as explicitly alleged by the Examiner in the "Response to Arguments" section of the Office Action dated September 1, 2009:

In paragraph [0035], Gray clearly discloses "step 1 and 2 can alternatively involve WAN user 52 requesting positions and/or directions (location means) to one or more nearby access points".

While the Examiner has placed the language indicated above in quotes as shown, the entire disclosure of Gray does not include such quotation as alleged by the Examiner, let alone paragraph [0035] of Gray which was explicitly cited by the Examiner as including the same. Nonetheless, the ACTUAL and entire disclosure of paragraph [0035] of Gray is addressed by the Applicants below, and is argued to not teach or even remotely suggest the above reproduced limitations of Claims 1, 7, and 13.

Continuing with the next step disclosed in Gray, step 3 of figure 5 of Gray is disclosed at paragraph [0036], lines 1-4 as follows: "If WAN user 52 elects to utilize the WLAN bandwidth on demand service, then the network provider receives an offer acceptance message from WAN user 52 and determines the current position of WAN user 52 in step 3."

Hence, step 1 of figure 5 of Gray involves a WAN user 52 receiving a message from the WAN network provider or MSC, the message relating to an e-mail with an attachment. Step 2 of figure 5 of Gray relates the network provider offering the WAN user 52 the option of purchasing WLAN bandwidth from nearby WLAN access point 24. Step 3 of figure 5 of Gray involves the network provider receiving an offer acceptance message from the WAN user and determining the current position of the WAN user if the WAN user 52 elects to the use the WLAN bandwidth on demand service.

Thus, it is clear right at the onset that the cited portions of Gray, which relate to steps 1 through 3 of figure 5 of Gray, do not involve the location of a wireless local area network WLAN, but rather involve the location of the WAN user. However, the explicit limitations recited in Claims 1, 7, and 13 relate to a user initiated request for a location of a wireless local area network (WLAN), and not for the location of the WAN user as disclosed in the cited portions of Gray. Hence, the cited portions of Gray clearly do not teach or even remotely suggest the above reproduced limitations of Claims 1, 7, and 13.

Moreover, while non-cited paragraph [0037] of Gray, which relates to steps 4 and 5 of figure 5 of Gray, discloses that a WAN/WLAN position location server 50 searches WLAN position database 54 for WLAN access points 24 that can service WAN user 52 in his/her current position in step 5, such searching is done responsive to the network provider transmitting the position information of WAN user 52 to the WAN/WLAN position location server 50 (see, e.g., Gray, para. [0037]), and not based upon a user initiated request for a location of a wireless local area network (WLAN) as recited in Claims 1, 7, and 13. That is, the WAN/WLAN position location server 50 disclosed in Gray automatically determines the

locations of WLAN access points 24 on its own initiative upon receiving position information of WAN user 52 from the network provider, and not based upon a user initiated request for a location of a wireless local area network WLAN as recited in Claims 1, 7, and 13.

Thus, it is clear that none of the preceding cited steps 1-5 of Gray involve “a user initiated request for a location of a wireless local area network” as explicitly recited in each of independent Claims 1, 7, and 13, but rather involve an offer to purchase WLAN bandwidth, the automatic determination of the location (without a user initiated request for such location) of the WAN user 52, and the automatic determination of the location (without a user initiated request for such location) of WLAN access points 24. The location of the WAN user 52 is automatically determined by the network provider if the WAN user 52 accepts the offer, and the locations of the WLAN access points 24 are automatically determined by the WAN/WLAN position location server 50 when the network provider transmits the position information of the WAN user 52 to the WAN/WLAN position location server 50. Hence, it is not surprising that Gray does not disclose “a user initiated request for a location of a wireless local area network” since Gray has no need for the same, given his different approach than that of the subject matters of Claims 1, 7, and 13. That is, while the subject matters of each of Claims 1, 7, and 13 involve an explicit user initiated request for a location of a WLAN, the approach of Gray involves an offer to purchase WLAN bandwidth where a location of WLAN access points are automatically determined based upon whether a network provider has transmitted position information of a WAN user 52 to a WAN/WLAN position location server 50, and not because of an explicit user initiated request for the location of the WLAN as explicitly recited in Claims 1, 7, and 13.

Lastly, it is to be noted that while paragraph [0035] of Gray discloses that “steps 1 and 2 can alternatively involve WAN user 52 requesting the WLAN bandwidth on demand service from its WAN network provider”, such alternative approach simply removes the offer of step 1 as the user him or herself is “requesting the WLAN bandwidth on demand service”, but does not change the automatic determination of location of the WAN user 52 or the automatic determination of the locations of WLAN access points 24, with such automatic determinations NOT based on a user initiated request for a location of a wireless local area network WLAN as explicitly recited in Claims 1, 7, and 13. Moreover, while paragraph [0035] of Gray does involve a “request”, such request is clearly for a WLAN bandwidth on demand service and NOT a location of a WLAN as recited in Claims 1, 7, and 13. That is,

requesting a service (as per paragraph [0035] of Gray) is not the same as requesting the location of a WLAN (as per the limitations of Claims 1, 7, and 13).

Hence, Gray fails to teach or suggest the above reproduced limitations of Claims 1, 7, and 13.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the "consideration" of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely "consider" each and every feature for this claim. Instead, the asserted combination of the patents must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make "a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art." See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious" (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Thus, Claims 1, 7, and 13 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above.

Claims 2-6 and 19 directly or indirectly depend from Claim 1 and, thus, include all the limitations of Claim 1. Claims 8-12 directly or indirectly depend from Claim 7 and, thus, include all the limitations of Claim 7. Claims 14-18 and 20 directly or indirectly depend from Claim 13 and, thus, include all the limitations of Claim 13. Accordingly, Claims 2-6 and 19 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 1, Claims 8-12 are patentably distinct and non-obvious over the cited references for at least the reasons set forth above with respect to independent Claim 7, and Claims 14-18 and 20 are patentably distinct and non-

obvious over the cited references for at least the reasons set forth above with respect to independent Claim 13.

Accordingly, reconsideration of the rejections is respectfully requested.

In view of the foregoing, Applicants respectfully request that the rejection of the claims set forth in the Office Action of September 1, 2009 be withdrawn, that pending Claims 1-20 be allowed, and that the case proceed to early issuance of Letters Patent in due course.

It is believed that no further additional fees or charges are currently due. However, in the event that any additional fees or charges are required at this time in connection with the application, they may be charged to applicants' Deposit Account No.07-0832.

Respectfully submitted,
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Date: November 5, 2009